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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,463	05/24/2001	Atsushi Ueda	L7016.01117	1242

7590

03/28/2003

STEVENS, DAVIS, MILLER & MOSHER, L.L.P.  
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Washington, DC 20036

EXAMINER
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DOVE, TRACY MAE

ART UNIT	PAPER NUMBER
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1745

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DATE MAILED: 03/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/863,463

Applicant(s)

UEDA ET AL.

Examiner

Tracy Dove

Art Unit

1745

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4-8,11 and 12 is/are rejected.
- 7) ☒ Claim(s) 2,3,9 and 10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Priority***

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1, 4-8, 11 and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Katsurao et al., US 6,372,388.

Katsurao teaches a non-aqueous battery having a positive electrode, a negative electrode and a non-aqueous electrolyte (col. 5, lines 3-20; col. 6, lines 51-58). The non-aqueous electrolyte comprises a polymer matrix and a non-aqueous electrolytic solution. The non-aqueous electrolytic solution includes an electrolyte salt and a non-aqueous solvent. The solvent may be propylene carbonate, methyl ethyl carbonate,  $\gamma$ -butyrolactone or diethylene glycol

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dimethyl ether (col. 6, lines 35-50). The electrolyte further contains a polymerizable crosslinking agent such as diacryl isocyanurate, triacryl isocyanurate or triallyl isocyanurate (col. 9, lines 30-44). The polymer electrolyte is prepared by dissolving 10g of vinylidene fluoride in 90g of tetrahydrofuran and then adding 1g of triallyl isocyanurate (compound of instant claims) as a crosslinking agent to prepare a first solution. The first solution was cast and tetrahydrofuran was evaporated before crosslinking. Then the crosslinked film was dipped in a second solution of 6g LiPF<sub>6</sub> dissolved in 30 ml of propylene carbonate (col. 12, lines 30-45). The negative electrode material may include carbonaceous materials, such as graphite (col. 8, lines 40-45).

Thus the claims are anticipated.

***Allowable Subject Matter***

Claims 2, 3, 9 and 10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: the claims are directed to a non-aqueous electrolyte comprising tri (2-methoxycarboxyethyl) isocyanurate, tris (2-carboxyethyl) isocyanurate or derivatives of tris (2-carboxyethyl) isocyanurate.

The prior art (US6,372,388) teaches an electrolyte for a non-aqueous battery having a compound of the formula of instant claim 1. However, the prior art does not teach an electrolyte having a compound of the formula of instant claim 1, wherein R<sub>1</sub>, R<sub>2</sub> and R<sub>3</sub> are all either 2-carboxyethyl or 2-methoxycarboxyethyl groups (all three R<sub>1</sub>, R<sub>2</sub> and R<sub>3</sub> are the same).

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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tracy Dove whose telephone number is (703) 308-8821. The Examiner may normally be reached Monday-Thursday (9:00 AM-7:30 PM). My supervisor is Pat Ryan, who can be reached at (703) 308-2383. The Art Unit receptionist can be reached at (703) 308-0661 and the official fax numbers are 703-872-9310 (after non-final) and 703-872-9311 (after final).

March 19, 2003

  
**Patrick Ryan**  
**Supervisory Patent Examiner**  
**Technology Center 1700**